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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,979	01/10/2002	Mamoru Kaneko	P/16-304	5661

7590

01/26/2004

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EXAMINER

LEUBECKER, JOHN P

ART UNIT	PAPER NUMBER
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3739

8

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,979

Applicant(s)

KANEKO ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 17 is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/153,793.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is indefinite. How can the first mode for conventional observation, which requires imaging by the imaging device for conventional observation and irradiation of the first illumination light by the light source, be established when the power supply of the endoscope is turned OFF? It appears that when the power is turned OFF, imaging can not occur, and a first mode can not be established.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi (U.S. Pat. 4,821,117).

Sekiguchi discloses the apparatus as described in numbered paragraph 3 of the previous Office Action. Although not previously pointed out, Figures 6 and 7 show that the imaging means can be two separate image sensors selectively selected by shutters (65,68). The Examiner maintains his position of obviousness with respect to initially setting the device to the white-light

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imaging/illumination mode when the device is turned on. Such obvious structure meets the limitations of the claimed controller (claim 10) wherein imaging by the pickup element (67) is prevented (by shutter 65 or the power being OFF) **UNTIL** the first mode has been established. Thus, when the endoscope/camera power is OFF, imaging by the imaging device for special observation is inherently prevented (no power, no imaging). Since the device is obviously turned on in the white-light imaging/illumination mode (as previously set forth and maintained), imaging by the imaging device for special observation is prevented (by shutter 65) until the device is manually switched to the fluorescent-light imaging/illumination mode.

Allowable Subject Matter

5. Claims 1-9 and 17 are allowed.
6. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: As amended, claims 1 and 2 now recited, in combination with other elements, an initial setting means for selecting the at least one white light imaging means prior to the setting by the setting means whereby the at least one fluorescent light imaging means is prevented from receiving light when the light source is turned on. The term "selecting" with respect to an imaging device is being interpreted, in correspondence with how it is used in the specification, as causing the

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imaging device to operate. Therefore, the at least one white light imaging means is selected *prior to* the setting means setting the specific light selected by the selection means. None of the prior art of record disclose such operation when the device is turned on. If anything, it appears that the white light imaging means of the prior art (e.g., Sekiguchi, Furusawa et al., Kaneko et al.) are selected simultaneously with the setting by the setting means. Therefore, claims 1 and 2 are allowable over the prior art of record. New claim 3 recites, in combination with other elements, an imaging prevention device which prevents imaging by the imaging device for special observation and a controller which controls the imaging prevention device so as to prevent imaging by the imaging device for special observation when the light source is in a transitional state. Consistent with the specification, a “transitional state” of the light source is being interpreted as that period of time between the ON and OFF states and between light source states (e.g., switching between emitting white light and emitting excitation light). None of the prior art of record explicitly disclose preventing imaging by the imaging device for special observation when the light source device is in a transitional state. It appears that the prevention of such imaging occurs during such transitional state (e.g., simultaneous switching of light source modes and imaging modes). Therefore, claim 3 is allowable over the prior art of record. As to claim 16, none of the prior art of record disclose the combination of elements including an image prevention device that controls the sensitivity of the imaging device for special observation. As to claim 17, none of the prior art of record fairly teach or suggest a combination of elements as claimed including the light detecting device and the controller as claimed. Therefore, claim 17 is allowable over the prior art of record.

Response to Arguments

8. Applicant's arguments, see pages 9 and 10, filed August 6, 2003, with respect to amended claims 1 and 2 have been fully considered and are persuasive. The rejection of these claims has been withdrawn. Note the Examiner's remarks on the Allowable Subject Matter above for a more detailed reason for withdrawal of the rejections and allowability of the claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Utsui et al. (U.S. Pat. 5,891,016)—note switching between normal and fluorescent imaging modes.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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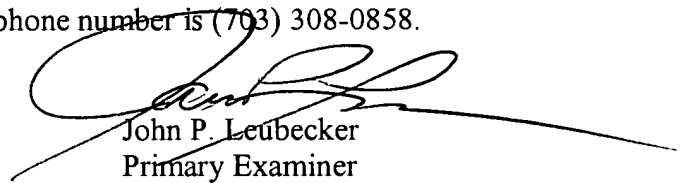
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl